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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,799	04/02/2004	Tatsuhiko Saito	50212-584	9333
20277	7590	03/10/2008		
MCDERMOTT WILL & EMERY LLP			EXAMINER	
600 13TH STREET, N.W.			HOFFMANN, JOHN M	
WASHINGTON, DC 20005-3096				
			ART UNIT	PAPER NUMBER
			1791	
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			03/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,799

Applicant(s)

SAITO, TATSUHIKO

Examiner

John Hoffmann

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-19-2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 8 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-8 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 2/19/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/19/2008 has been entered.

Double Patenting

Applicant is advised that should claim 14 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 7-8 and 14-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed determining step. On page 7 of the present response applicant indicates this step "is described in the specification as numbered at numbered paragraphs [0058], [0059], etc." Neither of these paragraphs refer to any determining. However, the following paragraph [0060] refers to determining a pressure, but it is the initial pressure in the tank. As Examiner understands the disclosure, the initial pressure is determined, and then adjusted so as to make the tank have the "pressure to be applied".

Nor is there any support for the assuming of claims 3 and 8.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 7-8 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 now requires "determining a pressure to be applied". Examiner could not find any explicit disclosure of such a determining step. The most relevant disclosure examiner could find was at [0060] which refers to determining an initial pressure in the tank. It is unclear whether the "pressure to be applied" is this pressure that would be applied, if it isn't changed. Or if it means that after the tank pressure is measured,

adjusted, it is then finally tested/determined (to ensure that it is the pressure that will be applied). Or if it means something else.

It is also unclear if "to be applied" should be construed as being the pressurizing step. In other words, the claims do not recite a step of applying the pressure. It would be unclear to a potential infringer whether a substantially identical process could avoid infringement only by not having an applying step. I.e. they could have a determining step which determines a pressure that has the same value as applicant, but that it is never "applied" thus it is not a "pressure to be applied."

Claim 3: it is unclear if the various "is determined" is the determining step of claim 1, or if it is an additional determining step. In other words there is confusing antecedent basis for the "determined".

The determining in accordance with the holes not yet fabricated is indefinite as to what is required. This is because it reads on a nebulous mental step conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the process steps must be positively recited. See Seagram & Sons Inc. vs Marzall, 84 USPQ 180. For example a potential infringer could claim: "I determined the pressure to create fiber with holes of d1, but my determining was not accurate - and I actually got a diameter of d2. It doesn't matter if I got the same diameter as recited in the claims, because my determining was in accordance with a completely different feature.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The step of “determining a pressure to be applied to the inside of the preform holes” of claim 1 (or even a pressure to be applied), and the assuming of claims 3 and 8 need to have to have antecedent basis in the specification. As pointed out in **MPEP 608.01(o)**:

Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner’s amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

As indicated above, examiner could not find any antecedent basis for the language and any support appears to be very unclear. Thus it is deemed that a prima facie showing has been made of lack of clear support or antecedent basis. The burden is now on applicant to demonstrate clear support or antecedent basis for the claim language.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 7-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa 2001/0038740 alone, or in view of Harvey 6284499.

See the prior Office action for the manner in which the art is applied.

Claim 1 now recites a step of determining a pressure. It is clear from [0086] of Hasegawa that pressure of 0.4 kPa was determined – somehow.

Claim 3: now relates to a pressure "when assuming that each diameter of the fiber holes is d..." The claim is silent as to anything if there is no assuming step. The

claim does not require a step of assuming. Since Hasegawa has no assuming step, the claim does not define over the combination of references. The same applies to claim 8.

The new claims which limit the tension would have been obvious for the same reason that claim 2 was found to be obvious.

Response to Arguments

Applicant's arguments filed 1-30-2008 have been fully considered but they are not persuasive.

It is argued that the new limitation in claim 1 "is described in the specification as numbered at numbered paragraphs [0058], [0059], etc." As pointed out above, examiner could not find any explicit or implicit support for the new limitation as presently claimed. The only determination is the determination is of a starting pressure in a tank.

It is also argued that subject matter of the holes are "applied with a pressure determined according to a fiber hole diameter" is not disclosed in the prior art. This is not very relevant because the claims do not require any "applying" step. Moreover, as indicated above, determining (as presently broadly disclosed) reads on a purely mental step. Nevertheless, it inherent that Hasegawa's pressure however it was obtained, was determined (be it on purpose or random) and it was in 100% accord with the final size.

Applicant further argues that the prior art does not express any recognition of the problem that applicant refers to or its solution. Examiner is not persuaded by this, because there is nothing which suggests that the claims are limited to the situation of a problem and its solution. Applicant asserts the problem relates to the behavior of holes

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on an inner side, vs. the behavior of holes on the outer side. But the present claims make no requirement of inner side holes and outer side holes. Thus the claims encompass a scope without the present problem. If applicant wishes to rely on such an indicia of non-obviousness, applicant must reasonably show that the claims are commensurate in scope with the evidence.

It is well established that the evidence relied on to establish unobviousness must be commensurate in scope with the claimed subject matter. See In re Kerkhoven, 626 F.2d 846, 851, 205 USPQ 1069, 1072-1073 (CCPA 1980) and IN re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Jmh

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